

## REMARKS

Claims 1 to 29 are pending in the present application.

Claims 1, 19, 22 to 24, and 28 are independent.

### Specification Objections

Applicants acknowledge the Examiner's comments regarding the use of trademarks in the specification. Based on the comments and the manner in which Applicants actually did respect the proprietary nature of the marks in the application, Applicants assume that the Examiner's comments were intended as merely a reminder and that the Examiner does not have any objections to Applicants specification other than the minor informality noted on page 2, which has been corrected herein. If Applicants are incorrect in this assumption, clarification is respectfully requested.

### Section 103 Rejections

Claims 1 to 23, 28, and 29 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over (1) a video game entitled "SameGame" by Amiga Freeware (hereinafter "SameGame") in view of (2) a passage from a book entitled "Casino Operation Management" by Kilby et al (hereinafter "Kilby"), (3) U.S. Patent No. 6,488,580 filed January 11, 2000 and issued December 3, 2002 to Robert w. Robb (hereinafter "Robb"), (4) an article entitled "Inside Pachinko: Skill or Pure Luck" by Brown (hereinafter "Brown"), and (5) a README file for a video game entitled "Black-Hole," version 1.0, by Oscar Sundblom (hereinafter "Sundblom"). Claims 24 to 27 stand rejected under 35 U.S.C. Section 103(a) as being unpatentable over U.S. Patent No. 6,273,420 filed July 13, 1999 and issued August 14, 2001 to Kenneth P. Brooks (hereinafter "Brooks") in view of U.S. Patent No. 4,248,422 filed May 3, 1979 and issued February 3, 1981 to Gene Messina (hereinafter "Messina"). Applicants respectfully traverse the Examiner's Section 103(a) rejections.

✱ Applicants respectfully object to the vague and incomplete format of the Examiner's rejection. Instead of identifying specific features in Applicants' claims and then identifying where within the relied upon references each feature is taught, the Examiner generalizes the language of Applicants' claims in reference to specific passages within the relied upon art without making it clear what specific features are allegedly taught by the passages. Further, with regard to some of the features of Applicants' claims, the Examiner does not provide a reference that discloses Applicants' claimed feature. Instead, the Examiner merely provides a conclusory statement that the particular feature, not shown in any reference, would have been obvious in light of the combined teachings of the reference. Such a rejection is improper. The Examiner is respectfully reminded that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." (See e.g. MPEP Section 2142) Applicants respectfully request clarification.

Partially due to the vagueness and incompleteness of the rejection and partially due to the absence of Applicants' claimed features in the relied upon references, the Examiner has not met her burden in that she has not established a *prima facie* case of obviousness. The Examiner has not identified anywhere within the relied upon references that the following features of Applicants' claimed invention are disclosed:

- reconfiguring the game board according to one of a plurality of reconfiguration rules
- wherein a reconfiguration rule to be applied during a game move is not indicated to the player during at least a portion of the game play.

The Examiner appears to rely upon the explanation of the operation of SameGame to support her assertion that it was known to reconfigure a game board according to one of a plurality of reconfiguration rules. While the operation of SameGame wherein “[a]fter a block is removed, the pieces above it drop down to fill the empty space . . . ,” may be characterized as a “reconfiguration rule,” it is clear from the SameGame reference that no plurality of reconfiguration rules are contemplated or even suggested. Despite the Examiner’s assertion to the contrary, it would be not obvious to not indicate a future reconfiguration rule where there is only one reconfiguration rule. In other words, since the reference only contemplates a single, static rule of operation, there cannot possibly be any suggestion that one of multiple rules will be later applied.

Further, the Examiner’s assertion that it would have been obvious to adapt SameGame by not disclosing to the player the effect of removing a block is entirely inconsistent with the “planning” nature of SameGame and would fundamentally change the game. The Examiner appears to be asserting that the references suggest changing SameGame in such a fundamental manner despite the fact that this simple game really only has one basic operating rule as described in the documentation.

The Examiner goes on to suggest that the Sundbom reference suggests a game having a plurality of reconfiguration rules. However, an initial direction (or type) of a next game piece is clearly not the same (or even suggestive of) a reconfiguration rule as Applicants’ specification describes the term. As explained on page 13, lines 19 to 24 of Applicants specification, the present invention reconfigures the game board according to one of a plurality of reconfiguration rules after receiving input from a player. This is clearly distinct from Sundbom’s “next piece” preview. Thus, no where in the relied upon references is disclosed “having a variety of reconfiguration rules to apply” as the Examiner incorrectly implies. Much less, Applicants’ claimed feature of “a reconfiguration rule to be applied during a game move is not indicated to the player” is not disclosed at all.

Beyond not demonstrating that all features of Applicants’ claims are taught by the numerous relied upon references, Applicants assert that the Examiner has not met her burden of establishing a *prima facie* case of obviousness for the additional reason that she has not provided a proper motivation to combine the references. The Examiner has improperly relied upon prohibited hindsight reasoning in providing her own motivation to combine the teachings of Kilby, Robb, Brown, SameGame, and Sundbom. Kilby teaches that a goal of casinos is to maximize its return on complimentaries issued (note the Examiner’s mischaracterization). Clearly there is no suggestion in Kilby to reconfigure the game board of a skill game like SameGame based on one of a plurality of reconfiguration rules with a indicating the rule to the player. Robb discloses that players like skill games and that score thresholds may be used in games of skill to insure casino profits. Clearly there is no suggestion in Robb to reconfigure the game board of a skill game like SameGame based on one of a plurality of reconfiguration rules with a indicating the rule to the player. Brown discloses that pachinko is controlled by a

computer and outcomes are based purely on chance. Clearly there is no suggestion in Brown to reconfigure the game board of a skill game like SameGame based on one of a plurality of reconfiguration rules with a indicating the rule to the player. SameGame, tetris type game, does not contemplate changing rules and, as discussed above, would be fundamentally altered by doing so. Clearly there is no suggestion in SameGame to reconfigure the game board of a skill game like SameGame based on one of a plurality of reconfiguration rules with a indicating the rule to the player. Finally, Sundbom teaches providing a preview of the initial direction of a next piece. Clearly there is no suggestion in Sundbom to reconfigure the game board of a skill game like SameGame based on one of a plurality of reconfiguration rules with a indicating the rule to the player.

Based the above listed teachings, the Examiner incorrectly determined that each element of Applicants' claims were taught. Further, the Examiner incorrectly determined that references together suggest (1) it would be desirable to make a skill game like SameGame available in a casino environment because SameGame is a skill game which attracts casino players, (2) that SameGame could be modified to be suitable for a casino environment by changing its rules so that it is not a skill game, and (3) that an effective means of changing the game's rules would be to change the game's reconfiguration rules during play without indicating the change to the player. Clearly the Examiner has improperly relied upon hindsight to pluck disparate ideas from among the five references, combine these ideas while ignoring the apparent contradictory teachings of the references, and to arrive at the above conclusions despite the fact that features of Applicants claims are not taught by the references. Thus, the only reason to make the Examiner's combination, would be to support hindsight reasoning to match Applicants' claims in an improper Section 103 rejection. For example, based on Robb, one might easily conclude that a game modified to not be a skill game would lose its appeal. Further, there is no suggestion that a skill game like SameGame would be the type of skill game that would be enjoyable in a casino environment. Since planning appears to be the fundamental challenge of SameGame, removing this basic element of the game may ruin the game. In another example of a contradiction ignored by the Examiner, Applicants claims recite not indicating a reconfiguration rule change to a player while the Sundbom teaches providing a preview of the initial direction of a next piece. Despite the Examiner's assertion to the contrary, Brown does not teach "rule adaptation" and it certainly does not suggest that "rule adaptation" results in casino profitability. The Examiner's arguments, particularly on page 6, lines 1 to 15, greatly overstate and misstate the teachings of the references and largely rely upon ideas not present in the references. Further, even if Applicants accepted the factual statements that the Examiner makes in stringing together the five relied upon references (which they do not), these statements are mere unsupported, uncorroborated and questionable assertions of the Examiner. Without a reference in support of the Examiner's assertions, the burden remains on the Examiner to show that Applicants' claims are obvious in view of the prior art. Therefore, the Examiner has not provided a proper motivation to combine Kilby, Robb, Brown, SameGame, and Sundbom, and Applicants respectfully request withdrawal the Section 103 rejection of Claims 1 to 23, 28, and 29 for this additional reason.

Regarding Claims 24 to 27, Applicants do not accept nor agree with the Examiner's characterization of the features of the claims that stand rejected based upon Brooks in view of Messina. More significantly however, the Examiner has not provided a reference that teaches:

- reconfiguring the game display based on the game input according to one of a plurality of game rules
- wherein a game rule to be applied during a game move is not indicated to the player during at least a portion of the game play.

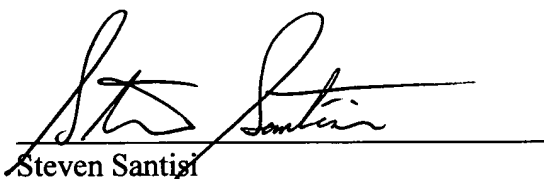
Further, the Examiner appears to have made a significant error in her reasoning and thus failed to establish a *prima facie* case of obviousness. She appears to be asserting that because Messina suggests making a game increasingly difficult as a player gains skill, it would be obvious to limit the ability of a skilled player to perform significantly better than an unskilled player. The Examiner's reasoning once again heavily relies upon questionable and unsupported factual assertions. For example, the Examiner states that "applying a vision setting during a game move that is not indicated to the player, a more challenging game would be created thus keeping the interest of the more experienced player." This is simply untrue. More experienced players are typically frustrated by a change to a game that eliminates skill (and/or experience) as an element of the game. Even if it was true however, it is an idea that the Examiner suggested and not the references. Thus, there is no suggestion within the references to make the combination the Examiner describes and the Examiner has not provided convincing reasoning that suggests the desirability of the proposed combination. There, Applicants respectfully request withdrawal of the Section 103 rejection of Claims 24 to 27.

### Conclusion

For the foregoing reasons it is submitted that all of the claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Applicants' representative, Steven Santisi, at telephone number 203-461-7054 or via electronic mail at [santisi@walkerdigital.com](mailto:santisi@walkerdigital.com).

Respectfully submitted,



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